

## REMARKS

The present application includes pending claims 1-37, all of which have been rejected. In particular, claims 1-37 stand rejected under 35 U.S.C. 102(e) **as being anticipated** by U.S. 2002/0112239 (“Goldman”). Without conceding that Goldman qualifies as prior art under 35 U.S.C. 102(e), the Applicants respectfully traverse these rejections for at least the reasons previously discussed during prosecution and the following.

As an initial matter, the previous final Office Action rejected claims 1-37 as being anticipated by Goldman. *See* April 21, 2008 Office Action. In response, the Applicants filed an Amendment Under 37 C.F.R. 1.116 in which independent claims 19 and 28 were amended. *See* May 9, 2008 Amendment. An Advisory Action was mailed indicating the amendment would not be entered because the claim amendments “raise new issues that would require further consideration and/or search.” *See* June 3, 2008 Advisory Action. Thus, the Advisory Action seems to imply that claims 19 and 28, as amended, are not anticipated by Goldman. Otherwise, the Advisory Action would have entered the proposed amendments “and an explanation of how the new or amended claims would be rejected” would have been provided, as is an explicitly listed option. *See id.* Nevertheless, the current Office Action merely reiterates the exact same rejection as the previous final Office Action, despite the Advisory Action indicating that the previous amendments to claims 19 and 28 “raise new issues that would require further consideration and/or search.”

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

**It is essential that patent applicants obtain a prompt yet complete examination of their applications.** Under the principles of compact prosecution, each claim should be reviewed

for compliance **with every statutory requirement for patentability in the *initial review of the application***, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel ***should state all reasons and bases for rejecting claims in the first Office action.*** Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. **Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved.** A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Manual of Patent Examining Procedure (MPEP) § 2106(II) (emphasis added). As such, the Applicants assume, based on the goals of patent examination noted above, that the Office Action has set forth “all reasons and bases” for rejecting the claims.

Further, this Response does not amend any of the pending claims. Therefore, this Response cannot raise any new issues that would require a further search.

#### **I. Goldman Does Not Anticipate Claims 1-8**

The Applicants note that claims 1-37 stand rejected as being **anticipated** by Goldman. “A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in **a single prior art reference.**” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The **identical** invention must be shown in as complete detail as is contained in ... the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Independent claim 1 recites, in part, the following:

determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location];

sending notification of the media request to a second location, via a communication network, if the determining results in a match; and

refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match.

Goldman “relates to displaying information to viewers regarding the number of other viewers who are watching specified television programs.” *See* Goldman at [0003]. In particular, Goldman “relates to using a back channel to gather statistics relating to real time viewing behavior and using the gathered information to modify electronic program guides (EPGs) so as to inform viewers of the number of other viewers who are watching the television programs.” *See id.* In short, television viewing habits are assessed, and collective viewing stats are shown on EPGs. *See id.* at [0009] (“The present invention relates to systems and method for utilizing a back channel as a feedback system to reveal what other television viewers are watching at a given moment.”).

Goldman discloses that home entertainment systems track whether a broadcast is viewed or recorded.

Home entertainment system 90 tracks each time broadcast 88 is output, recorded or otherwise utilized at home entertainment system 90, by generating viewer behavior information to indicate that the broadcast 88 was output, recorded or otherwise utilized at home entertainment system 90.

*Id.* at [0031]. EPGs are then updated and modified based on viewer behavior information. *See id.*, e.g., at [0044] (“once the viewing behavior information is received at the clearinghouse system 100, a processor 102 processes the information and/or makes the information available to modify the display of the EPGs of viewers in the system.”).

Thus, Goldman discloses a system in which viewer television habits are monitored, and those habits are compiled to update electronic program guides. The Applicants respectfully submit, however, that Goldman does not describe, teach or suggest “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the **requested media**] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication network, if the determining does not result in a match,” as recited in claim 1. There simply is nothing in Goldman that describes, teaches or suggests sending notification of a media request to a second location if an associated set of pre-defined characteristics associated with the requested media **matches** a parameter related to monitoring media consumption activity of a user at a first location. The Office Action has not shown where any cited reference describes, teaches or suggest such limitations. Thus, for at least these reasons, the Applicants respectfully submit that Goldman does not anticipate claims 1-8.

In response to the Applicants, the Office Action cites the following:

The Goldman reference has been relied upon to teach the selective gathering of viewer behavior information from a plurality of viewers – whereby the operator of a central clearinghouse 80 is able to define the type & volume of viewer behavior information (i.e. when the user tunes to or requests to view or record particular programming) (¶ [0022]) that is desired to be tracked – thereby controlling whether or not notification of view behavior gets sent to it in a real time manner (¶ [0035]-[0037] & [0039]). Specifically, Goldman teaches (¶ [0022]) the requesting of media by a viewer at a [sic] first location – whereby the media request is when the user tunes to a television program via a set top box (¶ [0022] & [0060]). Additionally, Goldman teaches that a clearinghouse 80 is able to dictate to a home entertainment system

which information is to be sent to it, thereby allowing the home entertainment system to determine which information is to be sent out and which information is not- by way of matching EPG information with information requested by the clearinghouse (§ [0036] & [0037]).

*See* July 18, 2008 Office Action at page 3 (emphasis added).

As shown above, however, independent claim 1 specifically recites “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication network, if the determining does not result in a match.” Thus, the claim is clear that if a determination is made **at the first location** that an associated set of **pre-defined characteristics** associated with requested media **match** at least one **parameter related to monitoring media consumption activity** of the user **at the first location**, then notification of **the media request** is sent to a **second location**. If there is no match, then no notification is sent.

As explained in detail above, Goldman merely discloses a system in which viewer television habits are monitored, and those habits are compiled to update electronic program guides. However, as shown above, the Office Action cites Goldman at ¶¶ [0022], [0035]-[0037], [0039] and [0060] as somehow disclosing the limitations of claim 1 reproduced above. *See* July 18, 2008 Office Action at page 3. In particular, the Office Action specifically relies on Goldman at ¶¶ [0036] and [0037] as disclosing “matching” predefined characteristics associated with requested media with at least one parameter related to monitoring media consumption activity of the user at the first location.

First, Goldman at ¶ [0022] states the following:

As under herein, unless otherwise specified, the term "number of viewers" when used to describe the viewing behavior or viewer activity associated with television programs, extends to absolute numbers of viewers, relative numbers of viewers, percentage of the viewing public, or any other metric that can indicate a degree to which a television program is being viewed, and is not limited to an absolute number of viewers. The "viewing behavior" associated with television programs extends to any viewer activity associated with television programs, including tuning and display of a television program that may be viewed in real time, recording a television program, scheduling a future recording of a television program, and setting a reminder to be displayed to a viewer for a television program indicating that the television program is to be broadcast. As used herein, the term "television" extends to any display device or system on which broadcast programming is displayed, and includes conventional television sets, personal computers or special purpose computing devices and their associated display devices on which broadcast programming can be displayed, or other such display device. The term "home entertainment system" extends to systems that include a television as defined herein along with a processing device that can perform the methods disclosed herein for monitoring the viewing behavior of the viewer, regardless of whether the system is included in a residence, a business, etc.

Goldman at ¶ [0022].

As shown above, this portion of Goldman sets forth term definitions. For example, "number of viewers" indicates a "degree to which a television program is being viewed." Further, "viewing behavior" includes "tuning and display of a television program that may be viewed in real time, recording a television program, scheduling a future recording," etc. Thus, while this portion of Goldman indicates "viewing behaviors" of particular viewers, it does not describe, teach or suggest "determining, **at the first location**, whether the associated set of pre-defined characteristics [associated with the requested media] **matches the at least one parameter** [related to monitoring media consumption activity of the user at the first location];

**sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication network, if the determining does not result in a match,” as recited in claim 1. In general, this portion of Goldman in no way describes, teaches or suggests sending notification of a media request from a first location to a second location based on whether there is a match between a set of pre-defined characteristics and a parameter.

Moving on, Goldman at ¶ [0035] discloses the following:

Therefore, information **describing the viewing behavior (e.g., tuning, display, recording, scheduled recording, or setting a reminder) associated with particular television programs is tracked at home entertainment system 90.** The tracking may be initiated upon the occurrence of an event performed by a viewer of home entertainment system 90. In this description and in the claims, the term "event" encompasses an instructional input received by a home entertainment system, whereby video data corresponding to broadcast 88 is output, recorded or otherwise utilized at home entertainment system 90. The input may be entered by the viewer or some other source. The term "event" also extends to other changes in programming displayed on the home entertainment system without viewer input, one example being the beginning of a scheduled program on an already-tuned channel.

*Id.* at ¶ [0035] (emphasis added). This portion of Goldman merely describes that information describing viewing behavior, such as tuning, display, recording, scheduling, etc., is tracked at a home entertainment system. **Notably, the viewing behavior at the home is tracked at the home entertainment system. That is, the viewing and tracking occur at the same location.** While this portion of Goldman discloses tracking viewing behavior at the same location as the viewing, it does not describe, teach or suggest “determining, **at the first location**, whether the associated set of pre-defined characteristics [associated with the requested media] **matches the**

**at least one parameter** [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request to a second location**, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request to the second location**, via the communication network, if the determining does not result in a match,” as recited in claim 1. In general, this portion of Goldman, while disclosing tracking, does not describe, teach or suggest sending notification of a media request based on a determination of whether a match exists.

Next, Goldman at ¶ [0036] states the following:

Once an event occurs, home entertainment system 90 **couples** the occurrence of the event with information specific to the program output, recorded, or otherwise utilized. This may include, for example, **coupling** unique IDs from an EPG to an occurrence of an event. The IDs identify such information as the program viewed and the channel tuned. Thus, a processor 94 at home entertainment system 90 that is coupled with computer-executable instructions represents one example of means for generating viewer behavior.

*Id.* at ¶ [0036]. Thus, when an event, which is an “instructional input received by a home entertainment system, whereby video data corresponding to broadcast is output, recorded or otherwise utilized at the home entertainment system” (*see id.* at [0035]) occurs, the home entertainment system 90 **couples** the event with information specific to the program output, recorded or otherwise utilized. That is, **the home entertainment system merely connects the event with information regarding the program output**. Goldman does not describe, teach or suggest, however, that the home entertainment system determines if a match exists. Instead, it merely discloses that the event is coupled to information. In general, this **coupling** of Goldman is a “means for generating viewer behavior.” Further, the “instructional input,” such as video data being output, recorded or otherwise utilized, **is an action, but not a request**.



Neither this portion, nor the remainder, of Goldman, describes, teaches or suggests “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] **matches** the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication network, if the determining does not result in a match,” as recited in claim 1.

Next, Goldman at ¶ [0037] states the following:

Depending on the type and volume of viewer behavior information that is desired to be tracked, **specific data corresponding to the broadcast can be requested remotely**. In general, the type of viewer behavior is at least sufficiently detailed to enable the system to determine the television program, if any, that is being displayed on the television. For example, the operator of central clearinghouse 80 to which the viewer behavior information is to be sent might decide that the desired types of information from the EPG that are to be included in the viewer behavior information are a channel ID, a subscriber ID, a program ID and title, the city and state of the channel, and the current date and time. Thus for each event, the foregoing information contained in the appropriate data fields of the EPG and information otherwise maintained at the home entertainment system is identified and stored as an instance of viewer behavior information.

*Id.* at ¶ [0037]. This portion of Goldman discloses that specific data corresponding to a broadcast can be requested, depending on the type and volume of viewer behavior. Information such as channel ID, subscriber ID, program ID, etc. may be stored. However, [0037], [0039], and the rest of **Goldman do not describe, teach or suggest that this “requested” data is in any way sent to another location based on a determination if a match exists between one set of information and another set of information**. That is, this portion of Goldman does not

describe, teach or suggest “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] **matches** the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media request** to the second location, via the communication network, if the determining does not result in a match,” as recited in claim 1.

Finally, Goldman at Next, Goldman at ¶ [0060] states the following:

The invention has been described above in the context of televisions having associated set-top boxes or processing devices that generate viewing behavior information and also in the context of modifying EPGs to display the number of viewers who are watching particular television programs. A specific example of a suitable set-top box or processing device that can be used with the invention is described below in reference to FIG. 6. However, it is to be understood that the invention can be practiced with substantially any television and associated processing device, including personal computers, dedicated Internet terminals, set-top boxes, embedded devices, etc.

*Id.* at ¶ [0060]. There is absolutely nothing in this cited portion of Goldman that describes, teaches or suggests a match, determining if a match exists, or a media request. Instead, this portion of Goldman merely discloses that the embodiments disclosed in Goldman may be used with set-top boxes or any television and associated processing device. It clearly does not describe, teach or suggest, however, “determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] **matches** the at least one parameter [related to monitoring media consumption activity of the user at the first location]; **sending notification of the media request** to a second location, via a communication network, if the determining results in a match; and **refraining from sending a notification of the media**

**request** to the second location, via the communication network, if the determining does not result in a match,” as recited in claim 1.

To summarize, the Office Action has not shown where any reference relied upon describes, teaches or suggests:

- **determining** at a **first location** whether a set of pre-defined characteristics associated with requested media **matches** a parameter related to monitoring media consumption activity of the user at the first location,
- sending notification of a media **request** (not consumption, *per se*, of the media) to a **second location** if the determination **results in a match**, or
- refraining from sending notification of a media **request** (not consumption, *per se*, of the media) if the determination **does not result in a match**.

Moreover, Goldman discloses that information about **every** “event” (viewing, recording, scheduling, etc.) is stored, and that **only certain information** about every stored event (i.e., all events that occur) is **sent to another location**. The Applicants respectfully submit that storing all events and sending back **only** information about **certain selected aspects of each and every event** is different than only sending back information about certain events (i.e., requests for media whose “associated set of pre-defined characteristics” matches “at least one parameter”), as recited in the pending claims.

The Applicants reiterate that a “claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in **a single prior art reference**.” *Verdegaal Bros.*, 814 F.2d at 631, 2 USPQ2d at 1053 (emphasis added). Moreover, the “**identical** invention must be shown in as complete detail as is contained in ... the claim.” *Richardson* 868 F.2d at 1236, 9 USPQ2d at 1920 (emphasis added). As detailed above,

however, Goldman does not describe, teach or suggest “each and every element” of the claims, nor does it show the “identical invention... in as complete detail as is contained in... the claim. The Applicants have demonstrated above that the portions of Goldman relied on by the Office Action do not describe, teach or suggest the limitations of claim 1, reproduced above. Thus, for at least these reasons, the Applicants respectfully request reconsideration of the claim rejections.

## **II. Goldman Does Not Anticipate Claims 9-18**

Claim 9 recites, in part, “receiving, at the second location via the communication network, **notification of a media request** by the user, at the first location, the requested media having an associated set of pre-defined characteristics matching the at least one parameter.” For at least some of the reasons discussed above, the Applicants respectfully submit that Goldman does not anticipate claims 9-18.

## **III. Goldman Does Not Anticipate Claims 19-27**

Claim 19 recites, in part, “the server software sending notification of a media request to a second location based on a determination as to whether a set of pre-defined characteristics associated with the requested media matches at least one parameter related to monitoring media consumption activity at the first location.” For at least some of the reasons discussed above, the Applicants respectfully submit that Goldman does not anticipate claim 19-27.

## **IV. Claims 28-37**

Claim 28 recites, in part, “the software sending notification of a media request to a second location based on a determination as to whether a set of pre-defined characteristics associated with the requested media matches at least one parameter related to monitoring media consumption activity at the first location.” The Applicants respectfully submit that Goldman does not anticipate claims 28-37 for at least some of the reasons discussed above.

## **VI. Conclusion**

In general, the Office Action makes various statements regarding claims 1-37 and the cited reference that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully request reconsideration of the claim rejections for at least the reasons discussed above. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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